



PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Emerson et al

Application No.: New U.S. Non-Provisional Patent Application

Filed: _____

Applicant's Docket No.: A0623

For: **Automatic Tab Displaying and Maximum Tab Storing User Interface And A Reproduction Machine Having Same**

Director of the U.S. Patent and Trademark Office
Washington, D.C. 20231

Sir:

DECLARATION OF TALLAM I. NGUTI

I, TALLAM I. NGUTI, hereby declare and state that:

1. I am a citizen of the United States with the address indicated below next to my signature.

2. I am a Xerox Corporation Patent Attorney in the Intellectual Property Law Department (IPLD). I am located in Rochester New York and Xerox Corporation headquarters are in Stamford Connecticut.

3. I am responsible for preparing, filing and prosecuting patent applications throughout the world for Xerox Corporation. As part of my responsibilities, I prepare draft applications for review by the inventor(s), and I coordinate with the inventors to prepare a final draft of the application for filing in the U.S. Patent and Trademark Office.

4. In October 1999, lead inventor William Emerson and 9 others listed as co-inventors (with Joseph Miska and Kelly J. Breuer listed respectively as Nos. 6 and 9 co-inventors) submitted a first Invention Disclosure (No. 991808) to IPLD entitled "User Interface Navigation Using Collapsible Tabs."

5. In June 2000, Kelly J. Breuer and Joseph Miska by themselves (with Kelly J. Breuer as lead inventor) submitted a second Invention Disclosure (A00983) to IPLD entitled "User Interface Navigation Using Folding Tabs" to cover a slight improvement over the first Invention Disclosure 991808.

6. The IPLD decided to combine both Invention Disclosures into one docket file, D/A2036.

7. From about May 2002, I started working with William Emerson (lead inventor 991808) and Joseph Miska (co-inventor A00983 because Kelly J. Breuer could not be reached) on drafting a patent Application to the combined disclosures.

8. On October 31, 2002, the prepared draft patent Application entitled "Automatic Tab Displaying and Maximum Tab Storing User Interface And A Reproduction Machine Having Same" was forwarded to the inventors their review and comments if required. A copy of the October 31, 2002, letter is attached.

9. Because we did not hear from Kelly J. Breuer, we on November 6, 2002 sent a letter of inquiry to the Director of the Xerox Business Division where Kelly J. Breuer was last working. A copy of the November 6, 2002, letter is also attached.

10. In response to our November 6, 2002 inquiry letter, we learned for the first time that Kelly J. Breuer had been terminated from Xerox for misconduct about a year earlier, which would have been about November 2001. See the November 6, 2002, letter. Actual termination date was May 9, 2001, see attachment (C).

11. All Xerox employees upon joining the company are required to execute a Proprietary Information and Conflict of Interest Agreement (PICIA) in which they agree to assign all rights to inventions they create during a term including the term of their active employment at Xerox. A copy of Kelly J. Breuer's PICIA is attached.

12. Since November 2002, we have made several efforts to find a current address and phone number for Kelly J. Breuer, including conducting an Internet search as well as using other sources. Our phone calls to the best phone information have gone to answering machines with no call-backs, and mail sent to the best last known address have been returned. See attached sheets including a photocopy of a returned mail envelope.

13. The filing of this application under 37 C.F.R. §1.47(b) is necessary to preserve the rights of Xerox Corporation and to prevent irreparable damage.

Kelly J. Breuer's signature on the Proprietary Information and Conflict of Interest Agreement evidences her agreement to assign the patent application to Xerox Corporation, and thus Xerox Corporation's rights in the application must be preserved. The facts outlined above show a diligent effort on behalf of Xerox Corporation to obtain the signatures of all inventors prior to the filing the patent application.

14. In view of the foregoing, it is clear that Xerox Corporation has a sufficient proprietary interest in this U.S. Patent Application.

15. I declare that all statements made herein of my own knowledge are true, and that all statements made on information and belief are believed to be true, and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under section 1001 of title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Tallam I. Nguti

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Attorney for Applicant(s)
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Attachments:

- (A). October 3, 2002 letter
- (B). November 6, 2002 letter
- (C). Xerox information
- (D). May 12, 2003 memo
- (E). Internet search sheets
- (F). Copy of front of Returned Envelope

TIN/km
6/19/03
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